



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/931,694	09/16/97	EVANS	R SALK1280-4

HM42/1231

STEPHEN E REITER
GRAY CARY WARE & FREIDENRICH
4365 EXECUTIVE DRIVE
SUITE 1600
SAN DIEGO CA 92121-2189

EXAMINER

JORDAN, K

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 12/31/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/931,694

Applicant(s)
Evans et al.

Examiner
Kimberly Jordan

Group Art Unit
1614



☒ Responsive to communication(s) filed on Oct 5, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 5-8, and 16-18 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 5-8, and 16-18 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

KIMBERLY JORDAN
PRIMARY EXAMINER
GROUP 1200

1610

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1614

Claims 1, 5-8, and 16-18 are pending in this application.

The amendment received on October 5, 1998 has been entered.

Claims 1, 5-8, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crettaz, Astrom, EPA 0170105 ('105), and EPA 0220118 ('118) for reasons of record. The applicants' remarks have been considered but are unpersuasive for the following reason.

Applicants argue that the references do not teach compounds which distinguish between subtypes of the same class of receptors. While it is true that the references do not label the compounds as selective ligands, the references do teach some of the claimed compounds to be administered to treat steroid responsive diseases as encompassed by the claims. For instance, as was set forth in the Office Action of April 1, 1998, the Crettaz reference teaches the compound of claim 16 (compound III) to selectively binds RAR receptor subtypes (page 395, Table 3, No. 6 and first column bridged to second column) and their use to treat retinoid responsive skin disorders and cancer (page 391, column 1, first paragraph). The method of treating subjects afflicted with steroid responsive diseases would have been obvious to a routineer because applicant's compounds were known to be useful for treating cancer and skin diseases. Note that the pharmaceutical methods are not limited by the possible mechanism of drug action because all mechanisms inherently occur upon administration of the drug regardless of the label given to the compound. Thus, the compound of claim 16 would inherently bind to certain receptor subtypes in a selective manner when the compound is administered to patients with skin disorders and cancer as was performed in the Crettaz reference. Applicants have not disclosed or claimed a selective

Art Unit: 1614


class of compounds which is distinct from the compounds of the prior art; nor have unexpected results been demonstrated relative to the claimed pharmaceutical methods to distinguish over the cited references. Thus, the claims remain obvious under 35 U.S.C. § 103.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

No claims are allowed.

Any inquiry concerning this communication should be directed to Kimberly Jordan at telephone number (703) 308-4611.


KIMBERLY JORDAN
PRIMARY EXAMINER
GROUP 1200
1610

JORDAN

December 29, 1998